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OFFICE OF PETITIONS

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In re Application of :
Stephane Cote :
Application No. 10/635,570 : DECISION ON TWO PETITIONS
Filed: August 7, 2003 : PURSUANT TO
Attorney Docket No. 36488- : 37 C.F.R. §§ 1.137(a) AND (B)
188318 :
Title: INTERACTIVE TOOL FOR :
REMOVAL OF ISOLATED OBJECTS ON :
RASTER IMAGES :

This is a decision on the petition filed August 23, 2007, pursuant to 37 C.F.R. § 1.137(a)¹, to revive the above-identified application. The submission is properly construed as also containing a conditional petition pursuant to 37 C.F.R. § 1.137(b)²

1 A grantable petition pursuant to 37 C.F.R. § 1.137(a) must be accompanied by:

- (1) the required reply (in a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof);
- (2) the petition fee;
- (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and;
- (4) a terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

2 A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed April 24, 2007, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting issue fees³. Accordingly, the above-identified application became abandoned on July 25, 2007. A Notice of Abandonment was mailed on August 17, 2007.

The petition pursuant to Rule § 1.137(a):

The standard

Nonawareness of a PTO rule will not constitute unavoidable delay⁴

The burden of showing the cause of the delay is on the person seeking to revive the application⁵.

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."⁶

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"⁷

(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

³ See MPEP § 710.02(e).

⁴ See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel. See also Donnelley v. Dickinson, 123 Fsupp2d 456, 459.

⁵ Id.

⁶ See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

⁷ See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action⁸.

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable"⁹.

The Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and the applicant is bound by the consequences of those actions or inactions¹⁰. Specifically, petitioner's delay caused by the mistakes or negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. § 133¹¹.

The actions of the attorney are imputed to the client, for when a petitioner voluntarily chooses an attorney to represent him, the petitioner cannot later distance himself from this attorney, so as to avoid the repercussions of the actions or inactions of this selected representative, for clients are bound by the acts of their lawyers/agents, and constructively possess "notice of all facts, notice of which can be charged upon the attorney"¹².

Courts hesitate to punish a client for its lawyer's gross negligence, especially when the lawyer affirmatively misled the client," but "if the client freely chooses counsel, it should be bound to counsel's actions"¹³.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present¹⁴.

8 See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

9 Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

10 Link v. Wabash, 370 U.S. 626, 633-634 (1962).

11 Haines, 673 F.Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32; Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 103, 131 (Comm'r Pat. 1891).

12 Link at 633-634.

13 Inryco, Inc. v. Metropolitan Engineering Co., Inc., 708 F.2d 1225, 1233 (7th Cir. 1983). See also, Wei v. State of Hawaii, 763 F.2d 370, 372 (9th Cir. 1985); LeBlanc v. I.N.S., 715 F.2d 685, 694 (1st Cir. 1983).

14 In re Mattullath, 38 App. D.C. at (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550,

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account"¹⁵.

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable"¹⁶.

Application of the Standard to the Present Set of Facts

With the present petition, Petitioner has asserted that she prepared the issue fee transmittal, the accompanying fee transmittal form, and an internal filing receipt for electronic filing on July 20, 2007. Petitioner intended to e-file these documents, but for reasons that have not been made clear, these documents were never e-filed. Petitioner has further set forth that she believed that the e-filing had taken place.

Petitioner has not explained why she never e-filed these documents.

Petitioner has not explained why she believed that the e-filing had taken place, despite the fact that she did not e-file these documents.

Moreover, while this error might be considered unintentional, it does not rise to the high standard associated with the characterization of a failure to respond as "unavoidable". The present situation is similar to a docketing error, as set forth in MPEP § 711.03(c)(II)(C)(2). A similar mistake can be characterized as unavoidable, but only when the actor was an employee such as a docket clerk or a paralegal. **When the actor is a registered member of the patent bar, she is held to a higher standard than one of these aforementioned employees.** As such, Ms. Swindell's failure to e-file the aforementioned documents cannot be characterized as unavoidable.

Conclusion

Pursuant to the discussion above, the petition under 37 C.F.R. § 1.137(a) must be DISMISSED.

552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

¹⁵ Smith v. Mossinghoff, 671 F.2d at 538; 213 USPQ at 982.

¹⁶ Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

The petition pursuant to Rule § 1.137(b):

37 C.F.R. §1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. Since the statement contained in the present petition varies from the language required by 37 C.F.R. § 1.137(b)(3), the statement contained in the present petition is being construed as the statement required by 37 C.F.R. § 1.137(b)(3) and Petitioner must notify the Office if this is not a correct interpretation of the statement contained in the present petition.

The petition fee has been charged to Petitioner's Deposit Account, as authorized in the petition.

With the present petition, Petitioner has included a statement that is being construed as the proper statement of unintentional delay. The concurrently submitted issue fee shall serve as the required reply. A terminal disclaimer is not required.

The petition pursuant to 37 C.F.R. § 1.137(b) is GRANTED.

The Office of Patent Publication will be notified of this decision so that the present application can be processed into a patent.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225¹⁷. All other inquiries concerning the status of the application should be directed to the Office of Patent Publication at 571-272-4200.



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¹⁷ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.